

REMARKS**Summary of the Office Action**

Claims 1-7 have been withdrawn from further consideration.

Claims 8-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 2001071384 (hereinafter "JP384") in view of Black et al. (U.S. Patent No. 5,382,770) (hereinafter "Black") and EP 1063794 A2 (hereinafter "EP794").

Summary of the Response to the Office Action

Applicants have amended each of independent claims 8, 9, 13 and 14 to differently describe embodiments of the disclosure of the instant application. Accordingly, claims 8, 9, 13 and 14 currently remain pending for consideration.

Rejections under 35 U.S.C. § 103(a)

Claims 8-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP384 in view of Black and EP794. Applicants have amended each of independent claims 8, 9, 13 and 14 to differently describe embodiments of the disclosure of the instant application. To the extent that these rejections might be deemed to apply to the claims as newly-amended, they are respectfully traversed for at least the following reasons.

Applicants respectfully submit that JP384 discloses a laser processing apparatus for welding resin members to each other by using laser light, wherein one of the stacked resin members, located on the incident side of the laser light generated by the laser, has a property of

transmitting the laser light that is generated by the laser and the thermally radiating light that is generated by the welding area.

Applicants also respectfully submit that Black discloses a mirror 18 disposed between the laser and the resin members. However, Applicants respectfully submit that the mirror 18 in Black does not block light having a wavelength to become an observation wavelength for measuring a temperature of a welding area in the light generated by the laser in the manner specifically described in independent claim 8 of the instant application.

Applicants further respectfully submit that EP794 discloses a semiconductor laser and a filter. However, the filter in EP794 does not block light having a wavelength to become an observation wavelength for measuring a temperature of a welding area in the light generated by the laser in the manner specifically described in independent claim 8 of the instant application.

In other words, Applicants respectfully submit that an optical means for blocking light having a wavelength to become an observation wavelength for measuring a temperature of a welding area in the light generated by the laser is not disclosed, or even suggested, in any of the references of record, whether taken separately or in combination with each other.

Applicants note in this regard that such an advantageous optical means was created in association with the present invention upon the novel discoveries by Applicants of specific findings including (I) a semiconductor laser emits not only the laser light having an oscillation wavelength of the semiconductor laser, but also a weak light having a wavelength of 1500-2800 nm and (II) the temperature of a welding area cannot be measured accurately if the above weak light becomes noisy.

Applicants respectfully submit that a feature that a wavelength of 1500-2800 nm becomes an observation wavelength for measuring a temperature of a welding area may be asserted as being obvious. However, Applicants respectfully submit that a feature that a semiconductor laser emits not only the laser light having an oscillation wavelength of the semiconductor laser, but also a weak light having a wavelength of 1500-2800 nm is not obvious to any extent.

Applicants further respectfully submit that the present invention provides an advantageous effect in that when a light component having the wavelength removed by the filter in the light thermally radiating from the welding area is used, the temperature of the welding area (processing temperature) can accurately be detected without being affected by noise light caused by the semiconductor laser. Applicants respectfully submit that this is an outstanding effect which goes well beyond anything shown, or even suggested, in any of the applied JP384, Black, and EP794 references, whether taken separately or in combination with each other.

Accordingly, Applicants respectfully submit that a person having ordinary skill in the subject would not reach the advantageous combination of features described in newly-amended independent claim 8 of the instant application, even assuming, strictly arguendo, that they might be led to combine JP384, Black, and EP794 in the specific manner suggested by the Office Action. Applicants respectfully submit that independent claim 8 of the instant application, as newly-amended, includes significantly different features from the disclosures of the applied references, whether taken separately or in combination with each other. As a result, newly-amended independent claim 8 is patentable over the currently applied art of record.

Independent claims 9, 13 and 14 of the instant application have also been newly-amended to include similar features as discussed above with regard to independent claim 8 of the instant

application. Accordingly, similar arguments as discussed above with regard to independent claim 8 of the instant application also apply to independent claims 9, 13 and 14 of the instant application.

Applicants respectfully assert that the rejections under 35 U.S.C. § 103(a) should be withdrawn because JP384, Black, and EP794, whether taken separately or combined, do not teach or suggest each feature of independent claims 8, 9, 13 and 14 of the instant application, as newly-amended. As pointed out in MPEP § 2143.03, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).”

CONCLUSION

In view of the foregoing discussion, Applicants respectfully request the entry of the amendments to place the application in clear condition for allowance or, in the alternative, in better form for appeal. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants’ undersigned representative to expedite prosecution. A favorable action is awaited.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including

any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573.

This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

DRINKER BIDDLE & REATH LLP

Dated: October 2, 2008

By:

A handwritten signature in black ink, appearing to read "Paul A. Fournier", written over a horizontal line.

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